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EXAMINER

VERDIER, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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3745

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/680,400

Applicant(s)

ICHIRYU, TAKU

Examiner

Christopher Verdier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 7-2-02 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Applicant's Amendment dated July 2, 2002 has been carefully considered but is deemed non-persuasive. The proposed drawing changes have been approved by the examiner. The specification has been amended to correct most of the informalities set forth in the first Office action. Applicant has stated that the claims have been amended to overcome the claim objections set forth in the first Office action, however these amendments have not been made to the claims. The claims have been amended to overcome most of the rejections under 35 USC 112, second paragraph set forth in the first Office action. Correction of the above is noted with appreciation.

Applicant has argued concerning Swiss Patent 171,458 that claim 1 as amended now recites that the continuous bolt hole extends on walls of both casing segments, with the walls of the casing segments separating an interior of the hollow casing from an exterior of the hollow casing, and that these limitations define over the Swiss Patent, because in the Swiss Patent, the flange portions 3 and 4 are formed on an exterior surface of the pipe, and that the bolt connecting mechanism thereof crosses merely a portion of the pipe rather a portion of the pipe separating the exterior from the interior. These arguments are not persuasive because although Applicant has correctly characterized elements 3 and 4 as flange portions, they are integrally formed with the first and second casing segments and are thus considered to be integral with and a part of the walls of the casing segments, with the walls of the casing segments separating an interior of the casing from an exterior of the casing. That is, the wall is comprised by all parts of the pipes 1, 2 and the flanges 3, 4, respectively. Furthermore, the first 3 and second 4 casing segments have

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unnumbered bolt holes that form a continuous bolt hole when assembled together, in a manner similar to Applicant's Figure 1.

With regard to Applicant's argument that there is no motivation to combine the fastening assembly of the Swiss Patent in a casing that is flangeless and includes a larger sized fastener member to arrive at the present invention, because the Swiss Patent discloses a nut with a greater diameter than that of the bolt hole of flanges 3 and 4 and does not show a need to make the hole smaller, these features upon which applicant relies are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In addition, as set forth later below in the rejection under 35 USC 103, the motivation for combining the teachings of the Swiss Patent with a casing is for the purpose of reducing leaking by preventing the expansion differences between the bolts, nuts, and casings (which are high temperature pipes) from permanently changing the form of the bolts, nuts, or casings, and because the Swiss Patent is from the analogous art of high temperature pipe joints, one of ordinary skill in the art would have looked to the art of high temperature pipe joints in order to solve the problem of differential thermal expansion in high temperature hydraulic casings.

Concerning the rejection of claims 2-4 under 35 USC 103 as being unpatentable over Walsh in view of Swiss Patent 171,548, Applicant has argued that for similar reasons with regard to claim 1, these claims define over the combination. This argument is not persuasive because while in Walsh elements 16, 18 are flange portions, they are integrally formed with the first and

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second casing segments 10 and are thus considered to be integral with and a part of the walls of the casing segments, with the walls of the casing segments separating an interior of the casing from an exterior of the casing. That is, the wall is comprised by all parts of the casings 10, 10 and the flanges 16, 18, respectively. Furthermore, the first and second casing segments have bolt holes 20 that form a continuous bolt hole when assembled together, in a manner similar to Applicant's Figure 1.

With regard to the rejection of claims 2-4 under 35 USC 103 as being unpatentable over Applicant's Prior Art Figure 7 in view of Swiss Patent 171,458, Applicant has argued that Applicant's Prior Art Figure 7 does not disclose a continuous bolt hole crossing the joint faces and extending in walls of both casing halves separating an interior of the hollow casing from an exterior of the hollow casing as claimed in claim 2. These arguments are not persuasive because although elements 110b and 120b are flange portions, they are integrally formed with the first 110a and second 120a casing segments and are thus considered to be integral with and a part of the walls of the casing segments, with the walls of the casing segments separating an interior of the casing from an exterior of the casing. That is, the wall is comprised by all parts of the casing segments 110a, 120a and the flanges 110, 120b, respectively. Furthermore, the first and second casing segments have bolt holes 110c, 120c that form a continuous bolt hole when assembled together, in a manner similar to Applicant's Figure 1.

Specification

The disclosure is objected to because of the following informality: Appropriate correction is required.

On page 1, line 28, "consists" should be changed to -- consisting --.

Claim Objections

Claims 1-4 are objected to because of the following informalities: Appropriate correction is required.

In claim 1, line 3, "segments" should be changed to -- segment --.

In claim 1, line 17, "segments" should be changed to -- segment --.

In claim 2, line 4, "halves" should be changed to -- half --.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 9, "the hollow casing" lacks antecedent basis. In claim 4, line 3, "the fastening element" is inaccurate and should be changed to -- the fastening means --.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Swiss Patent 171,458 (figure 1). Note the split casing assembled by first 3 and second 4 casing segments having joined joint faces, with the first 3 and second 4 casing segments being provided with respective bolt holes (unnumbered) that are aligned with each other, such that when the first and second casing segments are assembled together, they form a continuous bolt hole, with the bolt hole in the first casing segment being provided with an internal screw thread (unnumbered), with a sleeve 9 having an external screw thread that is fitted into the bolt hole of the first casing segment by engaging the external screw thread of the sleeve with the internal screw thread of the bolt hole of the first casing segment, with a fastening bolt 5 having fastening means 6 and passing through the bolt hole of the first casing segment and the sleeve, with the fastening means abutting an end of the sleeve opposite to the joint face, with a tensile force exerted on the fastening bolt at the portion between the fastening means and the first and second segments flange portions, they are integrally formed with the first and second casing segments. The flange portions 3, 4, are considered to be integral with and a part of the walls of the casing segments, with the walls of the casing segments separating an interior of the casing from an exterior of the casing. That is, the wall is comprised by all parts of the pipes 1, 2 and the flanges 3, 4, respectively. The Swiss Patent meets the functional limitations set forth in the lines 26- 34 of

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claim 1, due to the fact that the structural elements thereof are the same as those set forth in the claims. Note however, that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. MPEP 2114.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walsh in view of Swiss Patent 171,457. Walsh discloses a fastening arrangements for a horizontally split casing for a hydraulic machine substantially as claimed including first and second casing halves 10 joined together by joining joint faces 16, 18, with the first and second casing halves being provided with bolt holes 20 that are aligned with each other when the first and second casing halves are assembled, to form a continuous bolt hole crossing the joint. Although elements 16, 18 are flange portions, they are integrally formed with the first and second casing halves 10 and are thus considered to be integral with and a part of the walls of the casing halves, with the walls of the casing halves separating an interior of the casing from an exterior of the casing. That is, the wall is comprised by all parts of the casings 10, 10 and the flanges 16, 18, respectively. However, Walsh does not disclose that the bolt holes in the first and second casing halves are provided with internal screw threads with a sleeve having an external screw thread that is fitted

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into the bolt hole of the first casing half and engages the internal screw thread of the bolt hole of the first casing half, with a fastening bolt having an external screw thread at one end that engages the internal screw thread of the bolt hole in the second casing half and fastening means at the portion apart from the external screw thread, with the fastening means abutting an end of the sleeve opposite to the joint face when the fastening bolt is screwed into the bolt hole of the second casing half, with tensile force being generated in the fastening bolt, with an external screw thread being provided on a shaft of the fastening bolt and a nut engaging the external screw thread acting as the fastening element for abutting the end face of the sleeve.

Swiss Patent 171,458 (figure 1) shows a fastening arrangement for a horizontally split casing including first 3 and second 4 casing halves joined together by joining joint faces, with the first 3 and second 4 casing halves being provided with unnumbered bolt holes that are aligned with each other when the first and second casing halves are assembled, to form a continuous bolt hole crossing the joint. The bolt holes in the first and second casing halves are provided with internal screw threads with a sleeve 9 having an external screw thread that is fitted into the bolt hole of the first casing half and engages the internal screw thread of the bolt hole of the first casing half, with a fastening bolt 5 having an external screw thread at one end that engages the internal screw thread of the bolt hole in the second casing half and fastening means 6 at the portion apart from the external screw thread, with the fastening means abutting an end of the sleeve opposite to the joint face when the fastening bolt is screwed into the bolt hole of the second casing half, with tensile force being generated in the fastening bolt, with an external screw thread 8 being provided on a shaft of the fastening bolt and a nut engaging the external screw thread acting as the fastening element for abutting the end face of the sleeve, for the

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purpose of reducing leaking by preventing the expansion differences between the bolts, nuts, and casings (which are high temperature pipes) from permanently changing the form of the bolts, nuts, or casings. The flange portions 3, 4, are considered to be integral with and a part of the walls of the casing segments, with the walls of the casing segments separating an interior of the casing from an exterior of the casing. That is, the wall is comprised by all parts of the pipes 1, 2 and the flanges 3, 4, respectively.

The Swiss Patent is from the analogous art of high temperature pipe joints, and one of ordinary skill in the art would have looked to the art of high temperature pipe joints in order to solve the problem of differential thermal expansion in high temperature hydraulic casings. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to form the casings of Walsh with the fastening and sleeve arrangement of the Swiss Patent, for the purpose of reducing leaking by preventing the expansion differences between the bolts, nuts, and casings from permanently changing the form of the bolts, nuts, or casings.

With regard to claim 3, which recites an enlarged diameter portion integrally formed on a shaft portion of the fastening bolt acting as the fastening means for abutting the end face of the sleeve, Official Notice is taken that bolts having hex heads at one end and a threaded shank at the other end are old and well-known in the art for the purpose of joining members together. Therefore, it would have been obvious to a person having ordinary skill in the art to replace the bolt 5 and nut 6 arrangement taught by the Swiss Patent 171,458 with a bolt having a hex head, such that the hex head replaces the nut 6, for the purpose of joining the casings together.

Claims 1-4 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Prior Art Figure 7 in view of Swiss Patent 171,457. Applicant's Prior Art Figure 7 discloses a fastening arrangements for a horizontally split casing for a hydraulic machine substantially as claimed including first 110a and second 120a casing halves joined together by joining joint faces, with the first and second casing halves being provided with bolt holes 110c, 120c that are aligned with each other when the first and second casing halves are assembled, to form a continuous bolt hole crossing the joint. The bolt hole 120C in the second casing half is internally threaded. Although elements 110b and 120b are flange portions, they are integrally formed with the first 110a and second 120a casing segments and are thus considered to be integral with and a part of the walls of the casing segments, with the walls of the casing segments separating an interior of the casing from an exterior of the casing. That is, the wall is comprised by all parts of the casing segments 110a, 120a and the flanges 110, 120b, respectively. However, Applicant's Prior Art Figure 7 does not disclose that the bolt hole in the first casing half is provided with an internal screw thread with a sleeve having an external screw thread that is fitted into the bolt hole of the first casing half and engages the internal screw thread of the bolt hole of the first casing half, with a fastening bolt having fastening means at the portion apart from the external screw thread, with the fastening means abutting an end of the sleeve opposite to the joint face when the fastening bolt is screwed into the bolt hole of the second casing half, with tensile force being generated in the fastening bolt, with an external screw thread being provided on a shaft of the fastening bolt and a nut engaging the external screw thread acting as the fastening element for abutting the end face of the sleeve.

Swiss Patent 171,458 (figure 1) shows a fastening arrangement for a horizontally split casing including first 3 and second 4 casing halves joined together by joining joint faces, with the first 3 and second 4 casing halves being provided with unnumbered bolt holes that are aligned with each other when the first and second casing halves are assembled, to form a continuous bolt hole crossing the joint. The bolt holes in the first and second casing halves are provided with internal screw threads with a sleeve 9 having an external screw thread that is fitted into the bolt hole of the first casing half and engages the internal screw thread of the bolt hole of the first casing half, with a fastening bolt 5 having an external screw thread at one end that engages the internal screw thread of the bolt hole in the second casing half and fastening means 6 at the portion apart from the external screw thread, with the fastening means abutting an end of the sleeve opposite to the joint face when the fastening bolt is screwed into the bolt hole of the second casing half, with tensile force being generated in the fastening bolt, with an external screw thread 8 being provided on a shaft of the fastening bolt and a nut engaging the external screw thread acting as the fastening element for abutting the end face of the sleeve, for the purpose of reducing leaking by preventing the expansion differences between the bolts, nuts, and casings (which are high temperature pipes) from permanently changing the form of the bolts, nuts, or casings. The flange portions 3, 4, are considered to be integral with and a part of the walls of the casing segments, with the walls of the casing segments separating an interior of the casing from an exterior of the casing. That is, the wall is comprised by all parts of the pipes 1, 2 and the flanges 3, 4, respectively.

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The Swiss Patent is from the analogous art of high temperature pipe joints, and one of ordinary skill in the art would have looked to the art of high temperature pipe joints in order to solve the problem of differential thermal expansion in high temperature hydraulic casings. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to form the casings of Applicant's Prior Art Figure 7 with the fastening and sleeve arrangement of the Swiss Patent, for the purpose of reducing leaking by preventing the expansion differences between the bolts, nuts, and casings from permanently changing the form of the bolts, nuts, or casings.

With regard to claim 3, which recites an enlarged diameter portion integrally formed on a shaft portion of the fastening bolt acting as the fastening means for abutting the end face of the sleeve, Official Notice is taken that bolts having hex heads at one end and a threaded shank at the other end are old and well-known in the art for the purpose of joining members together. Therefore, it would have been obvious to a person having ordinary skill in the art to replace the bolt 5 and nut 6 arrangement taught by the Swiss Patent 171,458 with a bolt having a hex head, such that the hex head replaces the nut 6, for the purpose of joining the casings together.

Claims 1-4 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Prior Art Figure 8 in view of Swiss Patent 171,457. Applicant's Prior Art Figure 8 discloses a fastening arrangements for a horizontally split casing for a hydraulic machine substantially as claimed including first 210a and second 220a casing halves joined together by joining joint faces, with the first and second casing halves being provided with bolt holes 210c,

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220c that are aligned with each other when the first and second casing halves are assembled, to form a continuous bolt hole crossing the joint. The bolt hole 220C in the second casing half is internally threaded. However, Applicant's Prior Art Figure 8 does not disclose that the bolt hole in the first casing half is provided with an internal screw thread with a sleeve having an external screw thread that is fitted into the bolt hole of the first casing half and engages the internal screw thread of the bolt hole of the first casing half, with a fastening bolt having fastening means at the portion apart from the external screw thread, with the fastening means abutting an end of the sleeve opposite to the joint face when the fastening bolt is screwed into the bolt hole of the second casing half, with tensile force being generated in the fastening bolt, with an external screw thread being provided on a shaft of the fastening bolt and a nut engaging the external screw thread acting as the fastening element for abutting the end face of the sleeve.

Swiss Patent 171,458 (figure 1) shows a fastening arrangement for a horizontally split casing including first 3 and second 4 casing halves joined together by joining joint faces, with the first 3 and second 4 casing halves being provided with unnumbered bolt holes that are aligned with each other when the first and second casing halves are assembled, to form a continuous bolt hole crossing the joint. The bolt holes in the first and second casing halves are provided with internal screw threads with a sleeve 9 having an external screw thread that is fitted into the bolt hole of the first casing half and engages the internal screw thread of the bolt hole of the first casing half, with a fastening bolt 5 having an external screw thread at one end that engages the internal screw thread of the bolt hole in the second casing half and fastening means 6 at the portion apart from the external screw thread, with the fastening means abutting an end of

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the sleeve opposite to the joint face when the fastening bolt is screwed into the bolt hole of the second casing half, with tensile force being generated in the fastening bolt, with an external screw thread 8 being provided on a shaft of the fastening bolt and a nut engaging the external screw thread acting as the fastening element for abutting the end face of the sleeve, for the purpose of reducing leaking by preventing the expansion differences between the bolts, nuts, and casings (which are high temperature pipes) from permanently changing the form of the bolts, nuts, or casings. The flange portions 3, 4, are considered to be integral with and a part of the walls of the casing segments, with the walls of the casing segments separating an interior of the casing from an exterior of the casing. That is, the wall is comprised by all parts of the pipes 1, 2 and the flanges 3, 4, respectively.

The Swiss Patent is from the analogous art of high temperature pipe joints, and one of ordinary skill in the art would have looked to the art of high temperature pipe joints in order to solve the problem of differential thermal expansion in high temperature hydraulic casings. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to form the casings of Applicant's Prior Art Figure 8 with the fastening and sleeve arrangement of the Swiss Patent, for the purpose of reducing leaking by preventing the expansion differences between the bolts, nuts, and casings from permanently changing the form of the bolts, nuts, or casings.

With regard to claim 3, which recites an enlarged diameter portion integrally formed on a shaft portion of the fastening bolt acting as the fastening means for abutting the end face of the

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sleeve, Official Notice is taken that bolts having hex heads at one end and a threaded shank at the other end are old and well-known in the art for the purpose of joining members together.

Therefore, it would have been obvious to a person having ordinary skill in the art to replace the bolt 5 and nut 6 arrangement taught by the Swiss Patent 171,458 with a bolt having a hex head, such that the hex head replaces the nut 6, for the purpose of joining the casings together.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Verdier whose telephone number is (703)-308-2638. The examiner can normally be reached on Monday-Friday from 10:00-6:30.

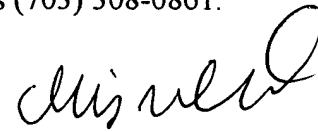
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward K. Look can be reached on (703) 308-1044. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

C.V.
August 25, 2002



Christopher Verdier
Primary Examiner
Art Unit 3745